

10/03/03  
16085 U.S. PTO

# UTILITY PATENT APPLICATION TRANSMITTAL

(New Nonprovisional Applications Under 37 CFR § 1.53(b))

Attorney Docket No.  
ALA-008H

## TO THE COMMISSIONER FOR PATENTS:

Transmitted herewith is a patent application identified as follows:

Inventors: Laurence B. Boucher, Stephen E. J. Blightman, Peter K. Craft, David A. Higgen, Clive M. Philbrick and Daryl D. Starr

Title: METHOD AND APPARATUS FOR DYNAMIC PACKET BATCHING WITH  
A HIGH PERFORMANCE NETWORK INTERFACE

22141 U.S. PTO  
10/678336



Which is a Continuing Application of:

U.S. Patent Application Serial No. 10/005,536, filed November 7, 2001;  
U.S. patent application serial number 09/384,792, filed August 27, 1999, now U.S. Patent No. 6,434,620;  
Provisional patent application serial number 60/098,296, filed August 27, 1998;  
U.S. patent application serial number 09/067,544, filed April 27, 1998, now U.S. Patent No. 6,226,680;  
U.S. patent application serial number 09/141,713, filed August 28, 1998, now U.S. Patent No. 6,389,479;  
Provisional patent application serial number 60/061,809, filed October 14, 1997;  
U.S. Patent Application Serial No. 09/464,283, filed December 15, 1999, now U.S. Patent No. 6,427,173;  
U.S. Patent Application Serial No. 09/514,425, filed February 28, 2000, now U.S. Patent No. 6,427,171;  
As listed in the Specification.

Applicants have annotated page 1 of the Specification in an attempt to comply with the new Patent Office requirements for indicating specified relationships (e.g., "continuation" or "continuation-in-part") between applications to claim the benefit of prior applications under 35 USC §120. Unfortunately, those new Patent Office requirements are vague and confusing, and contradict historic understanding as well as current and former laws and Patent Office rules. As such, applicants are unsure of how to characterize the various applications, and have provided the parenthetical terms on page 1 of the Specification to appease the Patent Office but cannot provide any assurance as to which of several unclear and contradictory relationship definitions the applications may assume.

For example, MPEP §201.07 (R1, Feb. 2003) states: "A continuation is a second application for the same invention claimed in a prior nonprovisional application and filed before the original prior application becomes abandoned or patented." However, MPEP §804, listing the requirements of double patenting rejections (including provisional rejections), states: "Where the claims of an application are substantively the same as those of a first patent, they are barred under 35 U.S.C. 101 - the statutory basis for a double patenting rejection. A rejection based on double patenting of the 'same invention' type finds its support in the language of 35 U.S.C. 101." Thus, according to the definition of continuation application provided by MPEP §201.07, no valid continuation of a patent can exist, in contrast to long-standing patent practice and many thousands of issued patents.

According to MPEP §201.08 (R1, Feb. 2003): "A continuation-in-part is an application filed during the lifetime of an earlier nonprovisional application, repeating some substantial portion or all of the earlier nonprovisional application and adding matter not disclosed in the said earlier nonprovisional application." This is in contrast to the Notice in the March 18, 2003 Official Gazette of the USPTO, which states: "the designation of an application as a continuation (rather than as a continuation-in-part) is an indication that the entire invention claimed in an application has support in the prior application, whereas the designation of an application as a continuation-in-part is an indication that the claimed invention is not entirely supported by the prior application." In other words, to define a CIP the MPEP looks to whether an application has added subject matter, whereas the Official Gazette Notice directs applicants to determine whether the claimed invention is entirely supported by the prior application, without regard to whether subject matter has been added.

Neither 35 U.S.C §120 nor 37 CFR §1.78 requires the characterization of an application as a continuation versus a divisional versus a continuation-in-part. Perhaps for this reason, the MPEP in effect a few months ago made it clear that the terms continuation, CIP, divisional, etc. had no legal significance. As stated in MPEP Edition 8, §201.11: "Continuing applications include those applications which are called divisions, continuations, and continuations-in-part. As far as the right under the statute is concerned the name used is immaterial, the names being merely expressions developed for convenience. The statute is so worded that the first application may contain more than the second, or the second application may contain more than the first, and in either case the second application is entitled to the benefit of the filing date of the first as to the common subject matter."

Given the vague, confusing and contradictory meanings proposed by the Patent Office, applicants are unsure what a "continuation application" is, what a "continuation-in-part application" is and what a "divisional application" is. Therefore, the terms "continuation" and "continuation-in-part" provided on page 1 of the Specification should not be relied upon by an Examiner or anyone else.

Enclosed are:

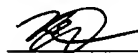
- 123 pages Specification
- 7 pages Claims
- 1 page Abstract
- 40 sheets Drawings
- 38 page Request to Provoke Interference
- 4 page copy of Declaration from prior application (09/384,792)
- 2 copies of a CD Appendix, each in a padded case
- 1 page CD Appendix Transmittal Sheet
- 1 check in the amount of \$1326.00
- 1 self-addressed, stamped postcard

Newly Executed Declaration Not Required:

A newly executed declaration is not filed in this application because, in accordance with 37 CFR 1.63(d)(1): the prior application contained a declaration as prescribed by 37 CFR 1.63; the continuation application (this application) is filed by all of the inventors named in the prior application; the specification and drawings in the continuation application (this application) contain no matter that would have been new matter in the prior application; and a copy of the executed declaration in the prior application is being submitted in the continuation application (this application).

CLAIMS AS FILED				
FOR	NO. FILED	NO. EXTRA	RATE	FEE
Total Claims	27	7	\$18.00	\$126.00
Independent Claims	8	5	\$86.00	\$430.00
Multiple Dependent Claims (if applicable)				\$0.00
Assignment Recording Fee				\$0.00
Basic Filing Fee				\$770.00
Total Filing Fee				\$1326.00

I hereby certify that this is being deposited with the U.S. Postal Service "Express Mail Post Office to Addressee" service under 37 CFR § 1.10 on the date indicated below and is addressed to: MS PATENT APPLICATION, Commissioner for Patents, P.O. BOX 1450, Alexandria, VA 22313-1450.


  
Mark Lauer

Date of Deposit: 10-3-03

Express Mail Label No.: ER 264470458 US

Customer No.: 24501

Respectfully submitted,

  
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**COMPACT DISC TRANSMITTAL LETTER**  
(under 37 CFR 1.52(e)3(ii))

Title: METHOD AND APPARATUS FOR DYNAMIC PACKET BATCHING WITH  
A HIGH PERFORMANCE NETWORK INTERFACE  
Assignee: Alacritech, Inc.  
Inventors: Laurence B. Boucher et al.  
Filing Date: October 3, 2003  
Docket No: ALA-008H

**TO THE COMMISSIONER FOR PATENTS:**

Sir:

Transmitted herewith are:

Two Labeled Compact Discs – Recordable (CD-R) – “Copy #1” and “Copy #2”,  
each in a CD case and contained in a padded envelope.

The content on the two discs is identical.

The machine format is: IBM-PC

The operating system is: MS-Windows

The creation date of the CDs is: October 3, 2003

The name, date and size of the file on the CD are listed below:

There is one file on each of the discs: ALA-008G CD APPENDIX (ASCII).txt. Its size is 57.8KB. It was created (written to disc) on October 3, 2003. It contains Appendices A, B, C, and D referenced in the textual part of the above-identified application.


I hereby certify that this correspondence is being deposited with the United States Postal Service as “Express Mail Post Office to Addressee” addressed to MS Patent Application, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313, on October 3, 2003, by Express Mail Label No.

ER 264470458 US.

  
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Mark A. Lauer

*10-3-03*  
\_\_\_\_\_  
Date

Respectfully submitted,

  
\_\_\_\_\_  
Mark A. Lauer  
Attorney for Applicants  
Reg. No. 36,578